

Remarks

Claims 1, 3, 4, and 6-25 are pending in the present application. Claims 6-22 have been withdrawn from consideration. Reconsideration of the instant application in view of the foregoing amendments and following remarks is respectfully requested. No new matter has been introduced by this Amendment.

Claim Rejections Under 35 U.S.C. § 103:

Claims 1, 3-4, and 23 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,213,062 ("the '062 patent"). The '062 patent discloses the compound dimethyldifluoromethanamine which is not claimed in instant claim 1. The Office Action contends that in view of the '062 patent, the instantly claimed compounds are obvious. Applicants respectfully disagree.

First, the compound of the '062 reference is not featured within the scope of the pending claims as amended. As discussed in previously submitted argument, which is hereby incorporated by reference, the Applicants have argued that the compound of the '062 patent does not disclose the compounds recited in claim 1. The Office contends that the instantly claimed compounds are mere homologues of the compound recited in the '062 patent, however, the compounds of instant claim 1 provide unexpected properties over those recited in the '062 patent. Attached hereto is a Declaration signed by one of the inventors where the inventor conducted an experiment using 1,1-difluoro-N,N-2,2-tetramethyl-1-propaneamine, a compound according to claim1, and 1,1-difluoromethyl-N,N-dimethylamine, a compound according to the '062 patent, as fluorination reagents for (2S-trans)-N-(tert-Butoxycarbonyl)-4-hydroxyproline benzyl ester. As shown in the Declaration, the compound according to present claim 1 produced a much higher diastereomeric excess than the compound according to the '062 patent (99% compared to 62%). The diastereomeric excess was obtained as a result of the fluorinating agents according to the present invention are more "bulky" than those of the '062 patent. This result would be unexpected to one of ordinary skill in the art. Therefore, the compounds of the present invention unexpectedly show benefits over the compound of the '062 patent, i.e., diastereomeric excess. It is hereby noted

that the Declaration contains an error in the Conclusion. The Conclusion should read, "In the foregoing Examples, 1,1-difluoro-N,N-2,2-tetramethyl-1-propaneamine, reagent according to the present invention..." and not "1,1-difluoromethyl-N,N-dimethylamine." This is supported by the fact that the instant claims do not include the compound 1,1-difluoro-N,N-2,2-tetramethyl-1-propaneamine and are not supported in the Declaration itself, see Example A of the Declaration. Correction to the Declaration via this Amendment is hereby requested.

The Applicants have shown that that the claimed compounds possess unobvious or unexpected beneficial properties not actually possessed by the prior art homologue, i.e., improved diastereomeric excess when used as a fluorinating agent, to rebut the presumption of obviousness presented by the Office. Application of Henze, 37 C.C.P.A. 1009 (Cust. & Pat.App. 1950). Therefore, such an unobvious or unexpected result would not be obvious to one skilled in the art.

The Office contends that, "the feature or property in which the superiority or advantage resides must be disclosed, or inherently flow from the disclosure." *See Page 4 of the Office Action*. However, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *See MPEP 716.02(f)*.

Withdrawal of the rejection is respectfully requested.

Further, claims 3 and 4 each directed or indirectly depend from claim 1 and are patentable over the cited reference for at least the same reasons as set forth with regard to claim 1. Withdrawal of the rejection of these claims is respectfully requested.

Claim 23 is directed to fluorinating agents comprising the compounds of formula (I). The '062 patent does not teach or suggest fluorinating agents comprising the compounds of formula (I) as recited in claim 23. Further, as shown above, the compounds according to formula (I) show unexpected results as fluorinating reagents over the compounds of the '062 patent. Therefore, claim 23 would not be obvious in view of the '062 patent. Withdrawal of the rejection of claim 23 is respectfully requested.


New claim 24 and recites compounds according to formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl and claim 25 recites use of the compounds of formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl as fluorinating agents. The '062 patent does not recited compounds of formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl or use of such compounds as fluorinating agents. As shown above, the compounds of formula (I) show unexpected results of the compounds of the '062 patent. As such, these claims are believed to be patentable over the cited art. Allowance of claims 24 and 25 is respectfully requested.

In view of the foregoing, claims 1, 3-4 and 23 are now in condition for allowance. A response to the Amendment in the form of a Notice of Allowability is hereby solicited.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 C.F.R. 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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